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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,350	04/03/2007	Matthias Pirsch	175.8345USU	2168

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OHLANDT, GREELEY, RUGGIERO & PERLE, LLP  
ONE LANDMARK SQUARE, 10TH FLOOR  
STAMFORD, CT 06901

EXAMINER
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CHAPEL, DEREK S

ART UNIT	PAPER NUMBER
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2872

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03/02/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/565,350	<b>Applicant(s)</b> PIRSCH, MATTHIAS	
	<b>Examiner</b> DEREK S. CHAPEL	<b>Art Unit</b> 2872	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/20/06, 4/3/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/20/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status Of Claims***

1. This Office Action is in response to an amendment received 1/20/2006 in which Applicant lists claims 1-13 as being currently amended. It is interpreted by the examiner that claims 1-13 are pending.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The Information Disclosure Statement(s) (IDS) filed on 1/20/2006 was considered.

### ***Drawings***

4. The drawings were received on 1/20/2006. These drawings are accepted.

### ***Specification***

5. The abstract of the disclosure is objected to because all instance of "comprises" should be changed to --includes--. Correction is required. See MPEP § 608.01(b).

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

7. Claims 1-7 and 9-11 are objected to because the claim(s) include(s) many limitations using the alternative language "and/or." Repeated use of "and/or" creates uncertainty as to metes and bounds of the claim because it is unclear from the multiplicity of combinations possible which features are intended to be included in the claimed combination. Claims 2-7 and 10-11 are objected to for inheriting the same informalities through their dependency from claims 1 or 9. For the purpose of this examination "and/or" has been interpreted as being "or".

8. Claims 5, 6 and 7 are objected to because of the following informalities:
- a. On line two of claim 5, "wherein overflow" should be changed to --wherein the overflow--;
  - b. Claim 6 is grammatically incorrect;
  - c. In claims 6 and 7, "that near the exit lens" does not make sense.
- Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 does not appear to be written in independent form and

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does not depend from any independent claims. For the purpose of the examination, claim 8 is interpreted to depend from claim 7.

11. Further regarding claim 8, the phrase “in particular” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-13, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hummel, International Publication WO 02/093232 A2 (hereafter Hummel, the English machine translation of which is referenced below).

14. As to claim 1, Hummel discloses a device for examining chemical or biological samples (see at least the first paragraph of the machine translation of Hummel), comprising a sample carrier for receiving the samples (see at least figure 1, elements 14 and 16), an objective for observing the samples through a sample carrier wall (see at least figure 1, elements 10, 12 and 18), wherein a gap is defined between an outer surface of the sample carrier wall and an exit lens of the objective (see at least figure 1, elements 12 and 22), a film of an immersion medium to be provided in the gap such that the film is in contact with both the outer surface of the sample carrier wall and the exit lens of the objective (see at least figure 1, element 46), and a protection means

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surrounding the exit lens for preventing the objective from becoming fouled by the immersion medium (see at least figure 1, element 44), wherein the protection means is connected with a suction means for discharging the immersion medium (see at least figure 1, elements 50 and 48 as well as page 2, the fifth full paragraph of the machine translation of Hummel), wherein the protection means comprises a capillary channel connected with the suction means for discharging the immersion medium (see at least figures 1 and 2, element 44).

15. As to claim 2, Hummel discloses that the capillary channel is essentially configured as an annular gap around the exit lens (see at least figures 1 and 2, element 44).

16. As to claim 3, Hummel discloses that the protection means comprises at least two collar portions arranged around the objective and defining the capillary channel (see at least figures 1 and 2, the inner and outer collar portions of element 44).

17. As to claim 4, Hummel discloses that the protection means comprises an overflow reservoir for additionally receiving immersion medium (see at least figures 1 and 2, element 44).

18. As to claim 5, Hummel discloses that the overflow reservoir comprises a reservoir bottom having a reservoir bottom opening via which the capillary channel is connected with the overflow reservoir (see at least figures 1 and 2, element 44).

19. As to claim 6, Hummel discloses a supply means comprising a supply line (see at least figure 1, elements 30 and 32), wherein an outlet opening of the supply line is arranged near the exit lens of the objective so that immersion medium is supplied into

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the gap at least partly with the aid of capillary forces (see at least figure 1, elements 34 and 36 as well as paragraph 12 of page 1 of the machine translation of Hummel).

20. As to claim 7, Hummel discloses that the capillary channel is connected with a supply means for supplying immersion medium (see at least figure 1, element 26), and the capillary channel comprises a capillary channel opening which is arranged that near the exit lens that immersion medium is supplied into the gap at least partly with the aid of capillary forces (see at least figure 1, elements 34 and 36 as well as paragraph 12 of page 1 of the machine translation of Hummel).

21. As to claim 8, Hummel discloses that the capillary channel is connected with a 3/2-way valve, wherein the valve is connected with the suction means and with the supply means (see at least figure 1, element 37 as well as well as paragraph 15 of page 2 of the machine translation of Hummel; it is noted that since the hose exiting the pump is fed into the valve and the discharge hose can be fed into the valve, the valve would necessarily be a 3/2 way valve).

22. As to claim 9, Hummel discloses a method for examining chemical or biological samples (see at least the first paragraph of the machine translation of Hummel), wherein an exit lens of an objective is arranged opposite a sample carrier for observing the sample through a sample carrier wall (see at least figure 1, elements 10, 12 and 18), wherein between an outer surface of the sample carrier wall and the exit lens of the objective a gap is defined (see at least figure 1, elements 12 and 22) such that in the gap a film of an immersion medium is arranged which is in contact with both the outer surface of the sample carrier wall and the exit lens of the objective (see at least figure 1,

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element 46), wherein via a capillary channel defined in the protection means surrounding the objective the immersion medium is discharged automatically, at least with the aid of capillary forces (see at least figure 1, elements 50 and 48 as well as paragraphs 10-12 of page 1 of the machine translation of Hummel).

23. As to claim 10, Hummel discloses that the immersion medium is supplied automatically, at least partly with the aid of capillary forces (see at least paragraphs 10-12 of page 1 of the machine translation of Hummel).

24. As to claim 11, Hummel discloses that the discharge of the immersion medium is adjusted relative to the supply such that the volume of the film of immersion medium essentially remains constant (see at least paragraphs 1-3 of page 2 of the machine translation of Hummel).

25. As to claim 12, Hummel discloses an objective cap (see at least figure 1, elements 10 and 44) for protecting an objective from becoming fouled by an immersion medium (see at least figure 1, element 46), comprising an inner collar portion adapted to be placed onto the objective (see at least figure 2, the inner collar portion of 44 and element 12), an outer collar portion arranged around the inner collar portion (see at least figure 2, the outer collar portion of element 44), wherein the inner collar portion and the outer collar portion are at least partly spaced relative to each other such that an essentially annular capillary channel is defined (see at least figures 1 and 2, element 44), and an outlet opening provided in the outer collar portion (see at least figures 1 and 2, element 50), via which opening the capillary channel is connected with a suction means (see at least paragraph 5 of page 2 of the machine translation of Hummel).

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26. As to claim 13, Hummel discloses an overflow reservoir arranged in the outer collar portion for receiving the immersion medium (see at least figures 1 and 2, element 44), wherein the overflow reservoir comprises a reservoir bottom having a reservoir bottom opening via which the capillary channel is connected with the overflow reservoir for discharging immersion medium (see at least figures 1 and 2, elements 48 and 50).

### ***Conclusion***

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEREK S. CHAPEL whose telephone number is (571)272-8042. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S. C./  
Examiner, Art Unit 2872  
2/23/2010

/Stephone B. Allen/  
Supervisory Patent Examiner  
Art Unit 2872